REMARKS/ARGUMENTS

The Examiner has asked for a certified copy of the German patent application for which the present application claims priority from, DE 100 33 855.0, filed July 12, 2000. A certified copy is enclosed with the Amendment.

As requested by the Examiner, an Information Disclosure Statement is filed with the present Amendment for the references cited in the Search Report.

As requested by the Examiner, the present application has been amended to conform to the preferred arrangement of the specification.

Claims 1-19 are pending in the present application.

Claims 8-19 are objected to under 37 C.F.R. 1.75(c) as having certain claims in improper multiple dependent form. The claims have been amended to remove the multiple dependency. It is respectfully requested that the objection be withdrawn.

Claims 1-19 are rejected under the doctrine of obviousness-type double patenting over claims 1-22 of U.S. Patent 6,303,141. The '141 patent claims a transdermal delivery system containing an ACE inhibitor that can be ramipril or trandolapril. The recitation of a prodrug (claim 4) or an active form of an ACE inhibitor (acid forms) (claim 5) do not render obvious the claims of the present application. The '141 patent provides the following definitions for active form and prodrug: active form is a dicarboxylic acid (col. 1, line 19); prodrug is a monoester of the dicarboxylic acid as a result of the esterifiction of one carboxyl group (col. 1, lines 19-20). In contrast, the present claims are directed to the use of the actual active form of a dicarboxylic acid of an ACE inhibitor that has been derivatised to form a diester or mono-salt of a dicarboxylic acid. Such an active form is not taught or suggested by the claims of the '141 patent. Accordingly, it is respectfully requested that the rejection of claims 1-19 under the doctrine of obviousness-type double patenting over claims 1-22 of the '141 patent be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent 6,303,141. Based on the above, the '141 patent does not anticipate or render obvious claims 1-7 of the present application. Accordingly, it is respectfully requested that the rejection of claims 1-7 under 35 U.S.C. 102(e) as anticipated by the '141 patent be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner asked how an ACE inhibitor in the form of a dicarboxylic acid can be converted to a mono-salt. Claim 10 recite how that mono-salt can be obtained. The Examiner states that claim 4 is indefinite. In response, claim 4 is amended. Accordingly, it is respectfully requested that the rejection of claims 1-7 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by EP 349430. The Examiner states that this reference teaches a transdermal system containing a di-salt of a dicarboxylic acid form of an ACE inhibitor (benazepril). Claims 1 and 2 are amended to delete recitation to the di-salt. Claims 1 and 2, as amended, recite the a transdermal system comprising at least one ACE inhibitor in the form of a dicarboxylic

acid that is derivatized to a diester or a mono-salt obtainable with acid(s). EP 349430 neither teaches or suggests such an ACE inhibitor.

Claims 3-7 are rejected under 35 U.S.C. 103(a) as obvious in view of EP 349430 and EP 452837 or U.S. Patent 5,362,497. EP 349430 teaches a transdermal system containing a di-salt of a dicarboxylic acid of a specific ACE inhibitor (benazepril) (page 6 bottom), but does not teach the use of a mono-salt or di-ester of the same nor the specific ACE inhibitors recited in claims 3-7. EP 452837 similarly does not teach the use of a mono-salt or di-ester of a dicarboxylic acid ACE inhibitor nor the specific ACE inhibitors recited in claims 3-7. Regarding delapril hydrochloride cited by the Examiner, delapril is not a dicarboxylic acid but a dicarboxylic acid monoester. Regarding (R)-3-[(S)-1-carboxy-5-(4-piperidyl) pentyl] amino-4-oxo-2,3,4,5-tetrahydro-1,5-benzothiazepine-5-acetic acid cited by the Examiner as an ACE inhibitor, this compound is not a mono-salt or a di-ester as recited in claims 3-7 of the present application. U.S. Patent 5,362,497 is cited by the Examiner as teaching a transdermal system comprising "acid derived mono salts of ACE inhibitors." Our review of this reference shows no part of the '497 patent teaches or suggests such acid derived mono salts. Accordingly, it is respectfully requested that the rejection of claims 3-7 under 35 U.S.C. 103(a) as obvious in view of EP 349430 and EP 452837 or U.S. Patent 5,362,497 be withdrawn.

If any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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